

71



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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/691,235 | 10/19/2000 | Katsuya Murakoshi | 198554US2 | 5024 |
| 22850 | 7590 | 01/26/2005 | EXAMINER | |
| OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314 | | | NGUYEN, MADELEINE ANH VINH | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2626 | |

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/691,235

Applicant(s)

MURAKOSHI, KATSUYA

Examiner

Madeleine AV Nguyen

Art Unit

2626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

This communication is responsive to amendment filed on September 13, 2004.

Applicant replaces Figs.1-6, amends the specification and claims 1, 7, 10, 16, 19, 20, 21, 24, 25, 26, 27.

Response to Arguments

Applicant remarks that Tadokoro appear to merely disclose changing a printing color of a communication log, whereas in the claims it is the received facsimile image data that is printed in different colors.

Tadokoro teaches that "In the above-described configuration, by outputting (for example, printing or displaying) a confidential document reception report and a confidential document reception message in the color registered for the confidential box storing the received confidential document, it is possible to determined to whom the confidential document has been transmitted by merely seeing the color of the report and the message." (col. 2, lines 13-21). Thus, the received confidential document can be printed in different color. Fig.24 is a schematic diagram showing an example of output paper. The transmitter's information, which is considered as the received fax data is printed in red. Thus, Tadokoro, not only teaches the changing a printing color of a communication log but also teaches the changing a printing color of the received facsimile data.

In addition, cited reference Sakai et al (US Patent No. 6,545,771) teaches the printing of predetermined color to the facsimile image data based on the communication type is shown in Fig. 8 (col. 10, lines 22-36).

Therefore, applicant's arguments filed on September 23, 2004 have been fully considered but they are not persuasive. The rejection of claims 1-27 is modified due to the amendments of the claims.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tadokoro et al (US Patent No. 6,359,707) in view of Sakai et al (US Patent No. 6,545,771).

Concerning claims 1 and 10, Tadokoro et al discloses a facsimile apparatus (Figs.1, 20) comprising at least one communication mechanism configured to transmit and receive facsimile data through a specific facsimile procedure (34, 35, 37, Fig.20); a printing mechanism configured to have a plurality of print colors (11, Fig.1); a memory (14, Fig.1) configured to store a first data table representing a relationship between the plurality of print colors and the at least one communications mechanism (Fig.2); a transfer sheet selection mechanism configured to select a type of transfer sheet (F24, Fig.11); and a processor (2, Fig.1) configured to select one of said plurality of print colors in accordance with data stored in the first data table when one of the

Art Unit: 2626

at least communications mechanism receives facsimile data and to instruct the printing mechanism to print the received facsimile data using the one of the plurality of print colors selected by the processor.

Tadokoro does not directly teach that the plurality of print colors is selected by the processor based on the at least one communications mechanism and corresponding specific facsimile procedure used to receive the facsimile image data. However, Tadokoro teaches in Fig.2 that received fax data of different color modes (F1) are printed in different color (F2) and Fig.6 that “black printing is performed for storage transmission/reception (storage communication) and blue printing is performed for direct transmission/reception)” (col. 6, lines 37-42). It would have been obvious to one skilled in the art at the time the invention was made to consider the processor in Tadokoro select one of the plurality of print colors based on the communications mechanism and corresponding specific facsimile procedure used to receive the facsimile data since Tadokoro teaches that the system have a plurality of communications mechanism configured to transmit and receive facsimile image data through a specific facsimile procedure such as color fax 34, Telex 35, G4 fax 37 (Fig.1) and the processor selects the print color based on the transmission/reception modes (Fig.2).

In addition, Sakai et al teaches a facsimile apparatus (Fig.1) having a processor 2 which select the printing color of the received facsimile image data based on different type of communications. For instance, “Fig. 8A shows the recording sheets Pa of one and same communication unit on which a monochromatic image from the originator’s terminal A is printed in a predetermined printing color Ma which is not monochrome and Fig.8B shows the recording sheets Pa of one and same communication unit on which a monochromatic image from

Art Unit: 2626

the originator's terminal B is printed in a predetermined printing color Mb which is not monochrome." (col. 10, lines 24-32). It would have been obvious to one skilled in the art at the time the invention was made to combine the above teaching of Sakai to the system in Tadokoro since both of them teach a system have a plurality of communications mechanism configured to transmit and receive facsimile image data through a specific facsimile and the processor selects the print color based on the transmission/reception modes.

Concerning claims 2, 3, 4, 5, 6, 7, 8, 9, 11, 12, 13, 14, 15, 16, 17, 18, Tadokoro further teaches that the processor select one of the plurality of print colors in accordance with data stored in the first table (Fig.2), (claims 2, 11); a second table representing a relationship between the plurality of print colors and identification information (Fig.17), (claims 3 12); the at least communications mechanism is configured to transmit and receive facsimile image data through at least one of G3 and G4 facsimile procedures (Fig. 20), (claim 4, 13); the identification information is selected from the group consisting of a transmitter terminal identification, a called station identification, and a remote terminal identification includes in a header of the received facsimile image data (Fig.16; col. 2, lines 26-38), (claims 5, 14); the memory further stores a second data and third tables representing a relationship among the plurality of print colors, type of transfer sheet, the communication mechanism on a basis of the communications mechanism used to received the facsimile data (Figs.2, 11, 12), (claims 6, 7, 8, 9, 15, 16, 17, 19).

Claims 19-27 are method claims of apparatus claims 1-18. Claims 19-27 are rejected for the same rationales set fort for claims 1-18.

Conclusion

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

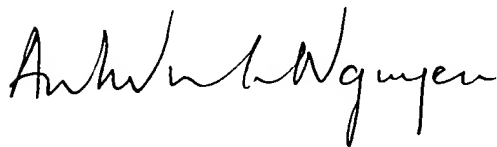
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Madeleine AV Nguyen whose telephone number is 703 305-4860. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A Williams can be reached on 703 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2626

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Madeleine AV Nguyen', written in a cursive style.

Madeleine AV Nguyen
Primary Examiner
Art Unit 2626

January 20, 2005